

REMARKS

The claims have been amended to recite formula (II) based on the disclosure at pages 10-11 in the application, as well as to address issues raised by the Examiner. The end of claim 27 has been amended to add a period, which had inadvertently been omitted previously.

Entry of the above amendments is respectfully requested.

Issue Regarding PTO-1449 Form

Applicants note that the Examiner did not initial the citation to EP 0 911 314 A on the Form PTO-1449 attached to the February 27, 2002 Office Action, probably as a result of an oversight. Accordingly, Applicants respectfully request that the Examiner consider this and initial this citation and attach a copy of the new initialed PTO-1449 to the next communication from the PTO.

Rejection under 35 U.S.C. § 112, First Paragraph

On page 2 of the Office Action, claims 1-39 are rejected under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification, while being enabling for certain eye disorders and certain diseases associated with apoptosis, does not reasonably provide enablement for all eye disorders associated with apoptosis and all diseases with apoptosis.

In response to this rejection, Applicants have amended the claims as shown above to replace the compound of formula (I) with that of formula (II). Applicants note that the 15-keto PG compound of formula (II) is disclosed in pages 10-11 of the original specification.

Applicants further note that the use of the compound is limited to "inhibiting apoptosis induced in the eyes" and "treating retinal cell disorder associated with apoptosis" as well as "photoretinitis". Applicants note that in the working example disclosed in the original specification, the treatment and exposure were conducted *in vivo* and a retinal preparation comprising an optic disc was used to determine the effect of the test compound to inhibit apoptosis induced in the eyes. However, Applicants believe the example does not mean the compound is solely useful for inhibiting apoptosis induced in retinal cells. Applicants submit that one skilled in the art would consider that the disclosure in the original specification is enabling for the invention as presently claimed.

Thus, Applicants submit that the rejection under 35 U.S.C. § 112, first paragraph, has been overcome, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection

On page 4 of the Office Action, claims 20-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Application 0 435 443.

The Examiner's position is that EP '443 teaches the use of the claimed prostaglandins for the treatment of conditions associated with apoptosis at page 3, lines 32-50.

In response, Applicants have amended the claims to recite a method for inhibiting apoptosis induced in the eyes and to treat specific disorders in the eyes.

Therefore, Applicants submit that the present invention is not anticipated by (or obvious over) EP '443, and withdrawal of this rejection is respectfully requested.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/816,655

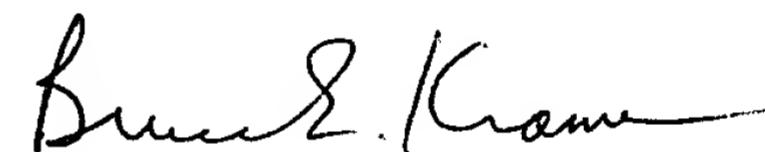
Attorney Docket No. Q58513

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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